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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re JoAnna Lynn

Serial No. 76470354

Sherrill Hondorf of Grubbs Hondorf Tabar Denham PLLC for
JoAnna Lynn.

M. Catherine Faint, Trademark Examining Attorney, Law
Office 103 (Michael Hamilton, Managing Attorney).

Before Seeherman, Hairston and Drost, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

JoAnna Lynn, an individual, has appealed from the
final refusal of the Trademark Examining Attorney to
register METAPHYSICAL EXERCISE as a mark for the following
goods and services:

Pre-recorded compact discs (CDs)
featuring meditations and recorded
music (Class 9);

Newsletters, training manuals,
notebooks and workbooks in the areas of

exercise, fitness and mental, spiritual and physical health (Class 16); and

Educational services, namely, seminars, workshops, classes and training programs all in the areas of exercise, fitness and mental spiritual and physical health (Class 41).¹

Registration has been refused on two grounds: (1) that applicant's mark so resembles the mark METAPHYSICAL, previously registered for "providing an online computer database in the field of evangelistic and ministerial services, namely information regarding religious or spiritual practices and beliefs"² that, if used on applicant's identified goods and as used in connection with applicant's identified services, it is likely to cause confusion or mistake or to deceive (Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d); and (2) that applicant's mark is merely descriptive of her goods and services (Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1)).

¹ Application Serial No 76470354, filed November 25, 2002. The application in Classes 9 and 16 is based on an asserted bona fide intention to use the mark in commerce (Section 1(b) of the Trademark Act); the application in Class 41 is based on a claimed date of first use and first use in commerce of May 2002 (Section 1(a) of the Trademark Act).

² Registration No. 2655026, issued November 26, 2002.

Applicant and the Examining Attorney filed appeal briefs.³ Applicant did not request an oral hearing.

We turn first to the refusal based on Section 2(e)(1) of the Trademark Act. A mark is merely descriptive, and therefore prohibited from registration by Section 2(e)(1), if it immediately conveys knowledge of the ingredients, qualities or characteristics of the goods or services in connection with which it is used. However, if a mark is suggestive, i.e., imagination, thought or perception is required to reach a conclusion on the nature of the goods or services, it is registrable. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

It is the Examining Attorney's position that applicant's mark is merely a combination of two descriptive terms that indicate the subject matter of applicant's goods and services, namely spiritual exercises. In support of the refusal, the Examining Attorney has made of record a definition of "metaphysical" as meaning "of or relating to the transcendent or to a reality beyond what is perceptible to the senses."⁴ The Examining Attorney asserts that the

³ Applicant also filed a reply brief that was untimely. Because applicant did not provide a satisfactory explanation as to why she filed the reply brief more than one month after it was due, applicant was advised, in a Board action mailed January 27, 2005, that the reply brief would not be considered.

⁴ Merriam-Webster Dictionary, www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=Metaphysical.

term "metaphysical" is often associated in the minds of the public with spiritual practices, pointing to excerpts of articles taken from the NEXIS database, including the following (emphasis added):

New Hope **Metaphysical** Society Group meets to promotes [sic] & support **spiritual** teachers, psychics, mediums & channelers. Pebble Hill Church, [address]...
"Philadelphia Inquirer," October 26, 2003

Headline: Shirley MacLaine discusses her dog Terry and new book "Out On A Leash"
MacLaine: ...And the experience with-with sleeping with the dog puts you into a **spiritual** kind of **metaphysical** other place.
"Today," October 21, 2003, NBC News Transcripts

Headline: One Man's Moving Memorial; Ron Broyles dedicated his bike ride across the U.S. to two men he never knew who had started such a trip, but were cut down
"...So maybe in some **metaphysical** and **spiritual** way, they did complete the trip."
"Los Angeles Times," October 15, 2003

Headline: Film Festival Review; Drowning In the Wake Of a Loss
...who discourses knowledgeably on chance, order and chaos theory. If his **metaphysical** speculations have the most intellectual substance, the movie suggests that they, too are little more than **spiritual** fishing expeditions.
"The New York Times," October 11, 2003

As such there is a **spiritual**, though it's unspecified—call it **metaphysical** if you will—aspect to individual works, and to the overall exhibition, that transports the visitor from the minutiae of daily concerns and draws him to transcendent considerations.
"Pittsburgh Post-Gazette," October 11, 2003

In addition, the Examining Attorney states that some of the third-party registrations that include the word METAPHYSICAL, and which were made of record by applicant, show that the USPTO has treated METAPHYSICAL as a descriptive term. In the following two registrations the word METAPHYSICAL has been disclaimed, and the registration for METAPHYSICAL CELEBRATION not only has a disclaimer of this word, but it is a Supplemental Register registration:

METAPHYSICAL CELEBRATION for
"educational and entertainment
services, namely, arranging and
conducting metaphysical lectures and
holistic healing or psychic reading
demonstrations and workshops"
(Registration No. 2149915)

METAPHYSICAL DNA for "educational and
entertainment services, namely
providing seminars to help people
better understand themselves and others
by using a person's birth date and time
of birth to determine the personality
traits of the individual later in life
(Registration No. 2701632)

The Examining Attorney also states that no disclaimer of METAPHYSICAL in the stylized mark ASTRO DEPOT (shown below)

was required because it appears as part of a unitary phrase.⁵

ASTRO DEPOT

HOME OF YOUR METAPHYSICAL NEEDS

Finally, we note that applicant's "class syllabus," which she submitted as a specimen in support of her application in Class 41, references certain spiritual aspects to the training, e.g., it begins with the quote, "When we exercise our body with a Divine purpose in mind, we allow all of God's good to move in and through us"; and during Week 2 it lists, as topics, Charles Fillmore's Interpretation of the Body (with a quote from Jesus Christ Heals), Emily Cady's Interpretation of the Body (with a

⁵ The only other current registration for a METAPHYSICAL mark in which METAPHYSICAL was not disclaimed is for METAPHYSICAL JONES for "entertainment services, namely, live musical performances by a musical band." Reg. No. 2671216. Three of the third-party registration submitted by applicant, and which did not contain a disclaimer of METAPHYSICAL, were cancelled or expired. They are GEOPHYSICAL TO METAPHYSICAL for "retail store services providing maps, books, flags, jewelry and crystals," (Reg. No. 1922666); REANISSANCE OF METAPHYSICAL IMAGERY for "works of fine art; original prints in mixed media" (Reg. No. 1721095) and ASTROMETAPHYSICAL SERVICES for "providing metaphysical and astrological consulting and counseling services (Reg. No. 1592484). In the latter registration, because METAPHYSICAL appears as part of the larger term ASTROMETAPHYSICAL, under Office practice it would not be disclaimed even if it were considered merely descriptive.

quote from Lessons in Truth) and A Course in Miracles' Interpretation of the Body (with a quote from A Course in Miracles). According to the syllabus, each class ends with "Song and Meditation." Further, in Week 4, which is entitled "Strengthening the 'Body Temple'; Practical Application of Weight Lifting Exercise, a subhead under "Introduction to Weight Lifting Exercise," along with "basic principles of weight lifting" and "physiological benefits of weight lifting," is "metaphysical view of weight lifting." A similar subhead, "metaphysical view of cardiovascular exercise," appears in Week 5's "Increasing the flow of 'God Life': Cardiovascular Exercise and Exercise Affirmations."

Given the statements in applicant's own specimens, and applicant's identifications in Classes 16 and 41, which state that the respective printed materials and educational outlets are in the areas of exercise and spiritual health, the individual words METAPHYSICAL and EXERCISE are descriptive of aspects of the goods and services. However, when the words are combined in the mark METAPHYSICAL EXERCISE, we think that the combination creates a certain incongruity. Normally exercise is thought of as involving physical exertion, especially when it involves health and fitness. The concept of the word METAPHYSICAL—"relating to

the transcendent or to a reality beyond what is perceptible to the senses"—is not normally related to the traditional notion of exercise and fitness, so that when it is combined with the word EXERCISE the combined phrase METAPHYSICAL EXERCISE causes a mental pause for the consumer to correlate the two ideas. It is because of that pause that we find METAPHYSICAL EXERCISE to be suggestive, rather than merely descriptive of applicant's goods and services.

It has often been said that there is but a thin line of distinction between a suggestive and a merely descriptive term. In *re Recovery, Inc.*, 196 USPQ 830 (TTAB 1977). Where reasonable people may differ, it has long been the practice of this Board to resolve doubt in applicant's favor and publish the mark for opposition. See *In re The Gracious Lady Service, Inc.*, 175 USPQ 380 (TTAB 1972). Thus, we reverse the refusal of registration on the ground that the mark is merely descriptive of the goods and services in Classes 16 and 41.

As for the goods in Class 9, nothing in the identification indicates that the compact discs involve exercise. Thus, in addition to the incongruity of the phrase METAPHYSICAL EXERCISE discussed above, with respect to the application in this class, we cannot even say that

both of the individual words in the mark can be considered merely descriptive.

Accordingly, for all three classes, we reverse the refusal of registration based on Section 2(e)(1) of the Act.

We turn now to the refusal based on the ground of likelihood of confusion in view of the registration for METAPHYSICAL for "providing an online computer database in the field of evangelistic and ministerial services, namely information regarding religious or spiritual practices and beliefs." In discussing the issue of descriptiveness, the Examining Attorney had essentially taken the position that METAPHYSICAL is a merely descriptive term for goods and services involving spiritual concerns, and pointed to the third-party registrations in which METAPHYSICAL was disclaimed an indicating an Office practice that supported that position. Here, of course, the mark is METAPHYSICAL per se, and the services involve providing information regarding spiritual practices and beliefs. Although METAPHYSICAL was registered on the Principal Register without resort to the provisions of Section 2(f) and although we must give the registrations all the presumptions that are accorded to it by Section 7(b) of the Act, we cannot simply ignore the evidence of the meaning of

the term "metaphysical" that was submitted in connection with the Section 2(e)(1) refusal. Thus, we must consider that the registered mark is highly suggestive of the identified services, and entitled to a very limited scope of protection.

In view thereof, we find that presence of the word EXERCISE in applicant's mark is sufficient to distinguish METAPHYSICAL EXERCISE from METAPHYSICAL. Specifically, METAPHYSICAL EXERCISE, because of the word EXERCISE, differs from METAPHYSICAL in appearance, pronunciation and, most especially, in connotation and commercial impression. We recognize that the word EXERCISE has a descriptive significance with respect to the goods in Class 16 and the services in Class 41. However, because of the incongruous effect, discussed above, the word EXERCISE has a stronger impact in the mark than a merely descriptive word normally would. Because of that incongruity, consumers are likely to treat the mark as a whole and remember the element EXERCISE as part of it. Thus, METAPHYSICAL EXERCISE must be viewed as a unitary mark, rather than a mark consisting of the dominant word METAPHYSICAL and the descriptive word EXERCISE. Therefore, comparing the marks in their entireties, we find that they are dissimilar.

In determining the issue of likelihood of confusion, we look to the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). Each of the thirteen elements may from case to case play a dominant role. DuPont, 476 F.2d at 1361, 177 USPQ at 567. Further, in a particular case, a single duPont factor may be dispositive. *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

In this case, we find that the factor of the similarity or dissimilarity of the marks in their entirety, coupled with the very limited scope of protection to which the cited registration is entitled, is dispositive. Therefore, even though we agree with the Examining Attorney that applicant's goods and services would be considered legally related to those identified in the registration, this factor is not sufficient to outweigh the dissimilarity of the marks factor. Nor is the factor of the channels of trade. In this respect we have assumed that applicant's goods, if not services, could be offered through the Internet, and therefore would be offered in the same channel of trade as the registrant's online database

services. The only remaining duPont factor the applicant or the Examining Attorney has discussed is the lack of any evidence of actual confusion. However, because applicant has not yet begun to offer her goods, and because her services have been offered only since 2002, and in a relatively limited geographic area, the fact that she is unaware of any confusion has very little probative value. We cannot conclude, based on this evidence, that this duPont factor weighs in her favor.

Accordingly, despite the duPont factors of relatedness of goods/services and channels of trade that weigh in favor of a finding of likelihood of confusion, we find that applicant's mark, if used on the identified goods and services, is not likely to cause confusion with the cited registration.

Decision: The refusals of registration on the grounds of Sections 2(d) and 2(e)(1) is reversed as to all classes of the application.